



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/530,759

06/23/2005

Eva-Maria Leppanen

59643.00602

9073

32294, 7590 08/08/2007
SQUIRE, SANDERS & DEMPSEY L.L.P.
14TH FLOOR
8000 TOWERS CRESCENT
TYSONS CORNER, VA 22182

EXAMINER

RECEK, JASON D

ART UNIT

PAPER NUMBER

2109

MAIL DATE

DELIVERY MODE

08/08/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/530,759

Applicant(s)

LEPPANEN ET AL.

Examiner

Jason Recek

Art Unit

2109

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☒ Claim(s) 17 and 26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 08 April 2005, 25 January 2007.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

This is in response to application 10/530759 filed on April 8th 2005, in which claims 1-30 are presented for examination.

Status of Claims

Claims 1-30 are pending, of which claims 1, 27 and 30 are in independent form.

Claims 17 and 26 is currently objected to.

Claims 1-17 and 21-30 are currently rejected under 35 U.S.C. 102(e).

Claims 18-20 are currently rejected under 35 U.S.C 103(a).

Claims 1-2, 13, 18, 23 and 28 are currently provisionally rejected under non-statutory double patenting.

Claims 1-30 are currently rejected under 35 U.S.C 112 second paragraph.

Specification

1. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Claim Objections

2. Claim 17 is objected to because of the following informalities: it recites "different for at least two users at least one group". It is believed the claim should read at least two users *in* at least one group. Appropriate correction is required.

3. A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general, applicant's sequence will not be changed. See MPEP § 608.01(n).

Claim 26 is objected to because it improperly depends from an earlier claim.

4. Claims 26 is further objected to because of the following informalities: it recites "said storage means receives from said requester, said storage means inserts..." it is not mentioned what is received from said requester, for initial examination purposes it is assumed a request is received. Also, there is a period after "wherein", a claim must only be 1 sentence. Appropriate correction is required.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

Art Unit: 2109

unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-2, 13, 18, 23 and 28 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2, 5-6, 10, 12-13 and 17 of copending Application No. 10/529577. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims would be obvious in view of each other.

Regarding claim 1, copending application 10/529577 discloses applications and servers (pg. 3, clm. 1) that can perform the functions of storing information and providing information.

Art Unit: 2109

It would have been obvious to one of ordinary skill in the art at the time of the invention to use a server to perform the functions of storing and providing information, these are well known functions.

Regarding claim 2, claim 6 of application 10/529577 discloses receiving information in response to a request.

Regarding claims 13 and 18, they are identical to claims 12-13 of application 10/529577.

Regarding claim 23, claim 2 of application 10/529577 discloses using an entity to receive presence information.

Regarding claim 28, claim 17 of application 10/529577 discloses filtering information.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 2109

8. Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 27 and 30, the claims recite "what parts of said presence information" the pronoun "what" raises a question that implies which thing or which particular one of many things. This render the claims indefinite.

Regarding claims 1-26 and 28-29 they are rejected for depending from a rejected claim.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-17 and 21-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Agrawal US 2002/0083127 A1.

Regarding claim 1, Agrawal discloses “a plurality of users with which presence information is associated” as multiple users having user presence data (pg. 2 paragraph 24, Fig. 1), “said presence information comprising a plurality of parts” as presence data may indicate multiple conditions (pg. 2 paragraph 25), “means for storing information defining at least one group, said group containing a plurality of users” as a buddy list (pg.2 paragraph 26), “means for providing information defining for said at least one user of said group what parts of said presence information are to be provided” as configuring user presence data to indicate specific states for certain users (pg. 4 paragraph 41).

Regarding claim 2, Agrawal discloses “said parts of said presence information is provided to at a requester in response to request from said requester” as providing presence data from the server to the client (pg. 3 paragraph 39, Fig. 4).

Regarding claim 3, Agrawal discloses “wherein said requester is one of said plurality of said users” as a user who configures their buddy list to show presence data of others is a requester of that data (pg. 2 paragraph 26).

Regarding claim 4, Agrawal discloses “said parts of said presence information is available only to one requester or to a plurality of requesters” as controlling who has access to presence information (pg. 4 paragraph 49).

Art Unit: 2109

Regarding claim 5, Agrawal discloses "said parts of said information provided is dependent on the identity of the requester" as only showing presence information to certain people (pg. 4 paragraph 49).

Regarding claim 6, Agrawal discloses "means for determining the identity of the requester making said request" as a buddy list user would necessary know the identity of the other users receiving the presence information (pg. 4 paragraph 41).

Regarding claim 7, Agrawal discloses "said storing means comprises a presence server" as a presence server (pg. 2 paragraph 24, Fig. 1).

Regarding claim 8, Agrawal discloses "said means for providing said information comprises a storage means" as an application server having a presence repository (pg. 4 paragraph 42, Fig. 11).

Regarding claim 9, Agrawal discloses "said means for storing and said providing means are provided by a common storage means" as a presence server and an application server that have access to a common presence repository (pg. 4 paragraph 41-42, pg. 5 paragraph 53, Fig. 11).

Regarding claim 10, Agrawal discloses "said means for providing said information comprises one of said users" as a user that provides presence information about himself (pg. 4 paragraph 49).

Regarding claim 11, Agrawal discloses "a separate address is provided for each of a plurality of groups" as using protocols HDTP/HDML or WAP or TCP/IP each message would have a unique address, thus each group would have a separate address (pg. 2 paragraph 27-9).

Regarding claim 12, Agrawal discloses "said users comprise user equipment" as a client/user consisting of a mobile device (pg. 2 paragraph 24, Fig. 1).

Regarding claim 13, Agrawal discloses "said presence information comprises at least one of the following parts of information: Subscriber status; Network status; communication means; Contact address, Subscriber provided location; Network provided location; text; priority; mood, favourite colour" as presence information includes at least network status – available or unavailable (pg. 2 paragraph 25) but may also include contact information and location (pg. 4 paragraph 41).

Regarding claim 14, Agrawal discloses "providing means provides information as to the parts of said presence information required" as providing the presence information requested (pg. 2 paragraph 25, pg. 3 paragraph 39).

Regarding claim 15, Agrawal discloses "providing means provides information as to the parts of said presence information not required" as providing more information than simply available or unavailable but also providing whether a user is available by cell phone, this information will often not be required for purposes of deciding whether a user is available to receive a message (pg. 4 paragraph 41, 48).

Regarding claim 16, Agrawal discloses "the parts of the presence information to be obtained is the same for all of at least one group" as configuring a buddy list to identify who is available, thus the same information is provided for all of the group (pg. 4 paragraph 41).

Regarding claim 17, Agrawal discloses "the parts of the presence information to be obtained are different for at least two users at least one group" as configuring a buddy list to identify who is available and configuring a buddy list to identify who is not available but reachable, thus different presence information is being obtained (pg. 4 paragraph 41).

Regarding claim 21, Agrawal discloses "said storing means is arranged to receive presence information from the users of said group" as presence information is sent from the users to the server where it is stored (pg. 2 paragraph 25).

Regarding claim 22, Agrawal discloses "said storing means is arranged to provide the parts of the presence information to be provided" as the server provides the presence information to other users (pg. 4 paragraph 41).

Regarding claims 23-24, Agrawal discloses "an entity associated with a user or a user of the group is arranged to provide to the parts of the presence information to be provided" and "said entity comprises a presence server" as a presence server associated with the users that provides presence information (pg. 2 paragraph 24, Fig. 1).

Regarding claim 25, Agrawal discloses "said storing means is arranged to add said parts of presence information to a request sent to said user or an entity associated with said user" as delivering an acknowledgment to the message originator concerning the user presence information (pg. 4 paragraph 44).

Regarding claim 26, Agrawal discloses "said storage means receives from said requester, said storage means inserts the parts of presence information into a request sent to said user or an entity associated with said user" as an application where a user configures a buddy list to inform user presence data, thus the storage means is inserting the user presence data for the requester (pg. 2 paragraph 26, pg. 3 paragraph 39, pg. 4 paragraph 41).

Regarding claim 27, Agrawal discloses “defining at least one group containing a plurality of users with which presence information is associated, said presence information comprising a plurality of parts” as a buddy list where users have presence information associated with them that comprises a plurality of parts (pg. 2 paragraph 26, pg. 4 paragraph 41), “defining for said at least one user of said group what parts of said presence information are to be provided” as specifying what presence information to receive (pg. 4 paragraph 41).

Regarding claim 28, Agrawal discloses “the step of filtering the presence information for at least one user of the group to obtain the defined parts of said presence information” as a user configuring what presence information to show and to whom, thus the presence information is “filtered” (pg. 4 paragraph 49).

Regarding claim 29, Agrawal discloses “the step of requesting for at least one user of said group said defined parts of said presence information” as a user wanting to know the presence information of another user of a group (pg. 3 paragraph 39).

Regarding claim 30, Agrawal discloses “means for storing first information defining at least one group, said group containing a plurality of users with which presence information is associated” as a buddy list that contains several users each user having presence information (pg. 2 paragraph 26), “said presence information comprising a plurality of parts” as presence information that comprises at least network

Art Unit: 2109

status (pg. 2 paragraph 25, pg. 4 paragraph 41), and "second information defining for said at least one user of said group what parts of said presence information are to be provided" as a user configuring what parts of presence information to provide (pg. 4 paragraph 49).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agrawal in view of Requena US 2007/0124471 A1.

Regarding claim 18, Agrawal does not disclose "the system operates in accordance with a session initiation protocol (SIP)" however this is taught by Requena as a presence information system that uses SIP (pg. 5 paragraph 73, pg. 13 paragraph 180-4, Fig. 11-2).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Agrawal with the SIP message SUBSCRIBE taught by Requena. The motivation for using SIP is that SIP carries presence information which is the object

Art Unit: 2109

of the invention, thus it would be natural to use SIP for the purpose of operating the system.

Regarding claim 19, Agrawal does not disclose "request for said presence information is made in a SUBSCRIBE request" however this is taught by Requena as a SUBSCRIBE request (pg. 13 paragraph 183, Fig. 11).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Agrawal with the SIP message SUBSCRIBE taught by Requena. The motivation for using SIP is that SIP carries presence information which is the object of the invention, thus it would be natural to use SIP for the purpose of operating the system.

Regarding claim 20, Agrawal does not disclose "the providing means comprise a SIP SUBSCRIBE message" however this is taught by Requena as a SUBSCRIBE message sent to the SIP server (pg. 13 paragraph 183, Fig. 11).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Agrawal with the SIP message SUBSCRIBE taught by Requena. The motivation for using SIP is that SIP carries presence information which is the object of the invention, thus it would be natural to use SIP for the purpose of operating the system.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bobde et al. US 2006/0190591 A1 discloses a network with presence information in response to subscription requests.

Salomaki US 2003/0065788 A1 discloses instant messaging with presence information.

Yoakum et al. U.S. 7,227,937 B1 discloses user presence information and filtering.

Grabelsky et al. US 2004/0003046 A1 discloses instant messaging using SIP and presence information.

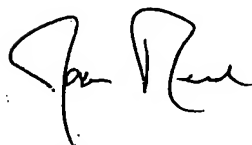
Mathis U.S. 6,993,327 B2 discloses distribution of presence information.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Recek whose telephone number is (571) 270-1975. The examiner can normally be reached on Mon - Thurs 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frantz Coby can be reached on (571) 272-4017. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2109

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jason Recek
8/6/07


FRANTZ COBY
SUPERVISORY PATENT EXAMINER